

Serial No. 10/056,312

Amendment in Resp. to Office Action of Mar. 24, 2004**UTILITY PATENT****B&D No. TN -1488****REMARKS**

Applicants have amended Claim 1 and canceled Claim 2. Currently pending therefore in the present application is Claim 1.

The Examiner has rejected Claim 1 under 35 USC §112, second paragraph for indefiniteness. Reconsideration and withdrawal of this rejection is respectfully requested.

In particular, the Examiner believes Claim 1 is indefinite because of the lack of explanation of the "first portion" and the "second portion" in the phrase "the distance between the second portion ... is smaller than a distance between the first portion." The Examiner is reminded that the primary purpose of 35 USC § 112, second paragraph, is "to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent." MPEP § 2173, at 2100-198 (8th ed., rev. 1, Feb. 2003). In other words:

In reviewing a claim for compliance with 35 USC § 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and therefore, serves the notice function required by 35 USC § 112, second paragraph by providing clear warning to others as to what constitutes infringement of the patent.

MPEP § 2173.02, at 2100-199 (*citing Solomon v. Kimberly-Clark Corp.*, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

Applicant submits that Claim 1 apprises a person skilled in the art of its scope and provides clear warning as to what constitutes infringement of the patent. Why? Because a

Serial N . 10/056,312

Amendment in Resp. to Office Acti n f Mar. 24, 2004

UTILITY PATENT**B&D N . TN -1488**

person skilled in the art would understand that the first and second portions are part of the arbor, where a first portion is "carrying the blade, [and] a second portion [is] disposed away from the blade," as called for in Claim 1. In other words, the person skilled in the art would need to (a) locate the arbor, (b) find the portion of the arbor carrying the blade (thus identifying the first portion), and (c) find a portion of the arbor disposed away from the blade (thus identifying the second portion).

Because persons skilled in the art will be able to accomplish such analysis, Claim 1 provides clear warning to others as to what constitutes infringement of the patent. Accordingly, Claim 1 is definite.

Applicants nevertheless remind the Examiner that "Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used" under MPEP § 2173.02. Accordingly, Applicants invite the Examiner to provide any suggestions for improving the clarity or precision of the used language.

The Examiner also rejected Claim 1 under 35 USC §112, first paragraph for failing to comply with the written description requirement. Reconsideration and withdrawal of this rejection is respectfully requested.

In the present case, the Examiner believes that Claim 1 contains "subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

DRAFT 1 OF 1

Serial No. 10/056,312**Amendment in Resp. to Office Action 1 Mar. 24, 2004****UTILITY PATENT****B&D No. TN -1488**

invention. In particular, the Examiner notes that the first and second portions are not described in the specification or indicated in the drawings.

To satisfy the written description requirement, “an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” MPEP § 2163.02, at 2100-171 (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991)).

Admittedly, the specification does not explicitly describe the first and second portions of the arbor. However, they are shown in the drawings, albeit without reference numerals. Under *Vas-Cath*, “drawings alone may provide a ‘written description’ of an invention as required by Sec. 112.” 19 USPQ2d at 1118. Attached is FIG. 13, which shows the arbor with the first and second portions.

As described above, a person skilled in the art would recognize that the first portion of the arbor is where the blade is disposed on, and that the second portion is a portion of the arbor away from the blade. These are shown in the attached FIG. 13 as 1P and 2P, respectively. While such reference numerals are not shown in original FIG. 13, Applicants submit that a person skilled in the art would easily identify the first and second portions based on the drawings and the claimed language.

Being that FIG. 13 shows the first and second portions, Applicants had possession of the invention, thus meeting the written description requirement. Therefore, Claim 1 should be

Serial No. 10/056,312**Amendment in Resp. to Office Action of Mar. 24, 2004****UTILITY PATENT****B&D No. TN -1488****allowed.**

The Examiner has rejected Claim 1 under 35 USC § 102(b) as anticipated by US Patent No. 5,425,294 ("Ushiwata"). In addition, the Examiner rejected Claim 2 under 35 USC § 103(a) as being unpatentable over Ushiwata in view of US Patent No. 3,757,838 ("Lee").

Reconsideration and withdrawal of these rejections is respectfully requested.

Since Claim 1 has been amended to incorporate the subject matter of Claim 2, Applicants will only respond to the obviousness rejection.

Claim 1, as amended, calls for a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly and having a plane, a saw assembly including a motor, and a blade disposed on an arbor, the arbor having a first portion carrying the blade, a second portion disposed away from the blade, and a first gear disposed on the second portion, an intermediate gear meshing with the first gear, and a second gear driven by the motor and meshing with the intermediate gear, wherein the intermediate gear is always meshing with the first and second gears, the second gear being driven by the motor via a belt, and a pivot arm pivotally attached to the table and supporting the saw assembly, the pivot arm and saw assembly being pivotable about a horizontal bevel axis from a first position where the blade is substantially perpendicular to the table to a second position where the blade is disposed at an angle relative to the table, the angle between the blade and the table being about 45 degrees, wherein a distance between the second portion and at least one of the base assembly and the table is smaller than a

Serial No. 10/056,312

Amendment in Resp. to Office Action of Mar. 24, 2004

UTILITY PATENT**B&D N . TN -1488**

distance between the first portion and the at least one of the base assembly and the table when the saw assembly is in the second position.

Ushiwata discloses all elements called for in Claim 1 except for the second gear being driven by the motor via a belt. The Examiner relies on Lee to provide such missing element because "it would have been obvious to provide a belt in Ushiwata as taught by Lee in order to mount the motor a greater distance from the pivot point of the pivot arm so that a greater miter angle can be achieved."

This rejection is improper as the Examiner has failed to make a *prima facie* case of obviousness. To establish such case, there must be some suggestion or motivation to one of ordinary skill in the art to combine the reference teachings. MPEP § 2143. In the present case, no such suggestion or motivation exists to combine Ushiwata and Lee as proposed by the Examiner because (a) such combination would change the principle of operation of Ushiwata, and (b) the modification proposed by the Examiner would contradict the teachings of both Ushiwata and Lee.

Under the MPEP, if the proposed "combination of the prior art would change the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01, at 2100-127 (*quoting In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Ushiwata discloses two embodiments. In the first embodiment (shown in FIGS. 1-2), the motor drives the blade arbor via a belt 13. In the second embodiment (shown in FIGS. 12-13),

Serial No. 10/056,312**Amendment in Resp. to Office Action of Mar. 24, 2004****UTILITY PATENT****B&D No. TN -1488**

the motor is connected to the arbor via an intermediate gear 17. Thus, in both embodiments, the motor is connected to the blade arbor via one intermediate link (either belt 13 or intermediate gear 17).

Similarly, Lee teaches that the motor should be connected to the blade arbor 80 via a belt 81. Accordingly, if Lee's belt 81 was to replace Ushiwata's intermediate gear 17, the resulting combination would be Ushiwata's first embodiment shown in FIGS. 1-2.

The Examiner somehow drums up a modification to obtain the claimed invention where belt 81 is not connected to the blade arbor, as shown in Lee, but instead such belt connects the motor and Ushiwata's top gear 12. The Examiner is unclear where in Ushiwata or Lee such suggestion can be found.

Nonetheless, such modification would change the proposed principle of operation of Ushiwata. As discussed above, Ushiwata's only embodiments show a motor connected to the blade arbor via one intermediate link. The Examiner is changing the principle of operation by providing Ushiwata with two intermediate links. Under the MPEP, such proposed modification is improper. Therefore, Claim 1 is allowable.

Furthermore, the Examiner's proposed modification contradicts the teachings of both Ushiwata and Lee. As discussed above, Ushiwata's only embodiments show a motor connected to the blade arbor via one intermediate link. Similarly, Lee discloses a motor connected to the blade arbor via one intermediate link. In other words, both references teach one intermediate link between the motor and the blade arbor. Such teaching contradicts and teaches away from the

Serial No. 10/056,312

Amendment in Resp. to Office Action of Mar. 24, 2004

UTILITY PATENT

B&D N . TN -1488

Examiner's proposed modification. Therefore, no suggestion to combine the references as proposed exists. Therefore, Claim 1 is allowable.

It is not surprising that no suggestion to combine the references as proposed exists. This is because Applicants have found that the claimed invention provides a higher cutting capacity in different cutting orientations than a saw with the same blade size incorporating the Ushiwata transmissions. Because of such advance, Claim 1 should be allowed.

In view of the foregoing, the claim is patentable and the application is believed to be in condition for formal allowance.

Respectfully submitted,



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